



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,458	11/26/2001	Ken K. Tseung	LABV / 04	9498
26875	7590	06/08/2004	EXAMINER	
WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			WALLENHORST, MAUREEN	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/994,458

Applicant(s)

TSEUNG ET AL.

Examiner

Maureen M. Wallenhorst

Art Unit

1743

eb

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14, drawn to an automated staining apparatus and reagent container for use in the staining apparatus, classified in class 422, subclass 102.
  - II. Claims 15-19, drawn to an apparatus for staining specimens carried on slides including a control system operatively coupled to an optical reader for retrieving reagent information on a two-dimensional data storage element associated with a reagent container, classified in class 422, subclass 67.
  - III. Claims 20-25, drawn to an apparatus for staining specimens carried on slides including a chassis with a processing space, a first drawer supporting a tray with slides thereon and a second drawer for supporting a reagent rack, classified in class 422, subclass 65.
  - IV. Claims 26-28, drawn to a method of operating an autostainer for staining a tissue specimen by reading a two-dimensional data storage element on a reagent container, classified in class 4364, subclass 43.
  - V. Claims 29-37, drawn to a method of operating an autostainer for staining a tissue specimen by importing and exporting staining information over a communication link between a remote computer system and an autostainer, classified in class 705, subclass 2.
2. The inventions are distinct, each from the other because of the following reasons:

Art Unit: 1743

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. The invention of Group I operates with a reagent container having a specific structure of an upper wall, a base wall and a nadir in the base wall, which is not required for the operation of the invention in Group II. The invention of Group II operates with a control system operatively coupled to an optical reader for retrieving information from a two-dimensional data storage element associated with a reagent container, which is not required for the operation of the invention of Group I.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. The invention of Group I operates with a reagent container having a specific structure of an upper wall, a base wall and a nadir in the base wall, which is not required for the operation of the invention in Group III. The invention of Group III operates with a chassis having a processing space, a first drawer for supporting a tray of slides, a second drawer for supporting a reagent rack and a cover, which are not required for the operation of Group I.

Inventions IV and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process of Group

Art Unit: 1743

IV can be practiced by another materially different apparatus since the method of Group IV does not require a reagent container having a specific structure of an upper wall, a base wall and a nadir in the base wall, which is required for the apparatus of Group I.

Inventions V and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process of Group V can be practiced by another materially different apparatus since the method of Group V does not require a reagent container having a specific structure of an upper wall, a base wall and a nadir in the base wall, which is required for the apparatus of Group I.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. The invention of Group II operates with a control system operatively coupled to an optical reader for retrieving information from a two-dimensional data storage element associated with a reagent container, which is not required for the operation of the invention of Group III. The invention of Group III operates with a chassis having a processing space, a first drawer for supporting a tray of slides, a second drawer for supporting a reagent rack and a cover, which are not required for the operation of Group II.

Inventions IV and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice

Art Unit: 1743

another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus since the method of Group IV does not require the robotic delivery system of Group II.

Inventions V and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process of Group V can be practiced by another materially different apparatus since the method of Group V does not require a control system operatively coupled to an optical reader for retrieving information from a two-dimensional data storage element associated with a reagent container.

Inventions IV and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process of Group IV can be practiced by another materially different apparatus since the method of Group IV does not require a chassis having a processing space, a first drawer for supporting a tray of slides, a second drawer for supporting a reagent rack and a cover.

Inventions V and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process of Group V can be practiced by another materially different apparatus since the method of Group V does

Art Unit: 1743

not require a chassis having a processing space, a first drawer for supporting a tray of slides, a second drawer for supporting a reagent rack and a cover.

Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. The invention of Group IV operates by reading a two-dimensional data storage element on a reagent container, whereas the invention of Group V operates by importing and exporting staining information over a communication link between a remote computer and an autostainer.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1743

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maureen M. Wallenhorst whose telephone number is 571-272-1266. The examiner can normally be reached on Monday-Wednesday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden, can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maureen M. Wallenhorst  
Primary Examiner  
Art Unit 1743

mmw

June 7, 2004

*Maureen M. Wallenhorst*  
MAUREEN M. WALLENHORST  
PRIMARY EXAMINER  
GROUP 1700